

In the October 26, 2007 Amendment, Applicants argued that independent claims 41-44 are not anticipated by U.S. Patent No. 6,667,795 B2 to Shigemura because this reference fails to disclose the at least one of the plurality of ejection heads that comprises a plurality of first nozzles for ejecting a first type of filter material, a plurality of second nozzles for ejecting a second type of filter material, and a plurality of third nozzles for ejecting a third type of filter material, the plurality of first, second and third nozzles being arranged in a same line, as positively recited in independent claims 41-44. The Amendment argued that the "same line" of Shigemura relied upon in rejecting claims 41-44 in the September 14, 2007 Office Action was not, in fact, oriented perpendicular to a head scan direction, as recited in the independent claims. Applicants also argued that Fig. 16 of Shigemura fails to disclose, contrary to the assertion of the September 14, 2007 Office Action, a plurality of first, second and third nozzles arranged in a same line, as recited in claims 41-44.

In response to these arguments, the Office Action maintaining the rejection of claims 41-44 under 35 U.S.C. §102(e) over Shigemura, and newly rejects claims 45-48 under 35 U.S.C. §102(e) over Shigemura. In support of the rejection of pending claims 41-48, the Office Action relies on a portion of Shigemura not relied upon in previous Office Actions. In particular, the Office Action relies on Fig. 26 of Shigemura, and the descriptions of this figure provided in Shigemura at col. 23, lines 21-48, which allegedly teaches a method of rotating head unit 606 shown in Figs. 16 and 26. The Office Action asserts that the rotated head unit 606 is positioned in a manner that teaches all of the features recited claims 41-44. For the following reasons, this assertion is unreasonable.

First, rotation of the Shigemura device as shown in Fig. 26 places the Shigemura device in a rotated position that fails to meet at least the feature of a plurality of ejection heads being arranged perpendicular to a head scan direction, as positively recited in independent claims 41-44. Second, the Shigemura device even in its rotated state, fails to

teach a plurality of first nozzles, a plurality of second nozzles, and a plurality of third nozzles arranged in a same line as positively recited in claims 41-44. None of the lines identified in the September 14, 2007 Office Action or the pending Office Action can reasonably be interpreted as teaching a plurality of first nozzles, a plurality of second nozzles, and a plurality of third nozzles arranged in a same line, as positively recited in the independent claims.

In reviewing the anticipation standard, the Federal Circuit has stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). Additionally, other court precedent clarifies the requirements for anticipation, stating that "the reference ... must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524 (CCPA 1972); *see also Sandisk Corp. v. Lexar Media, Inc.*, 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device' ").

This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the . . . claim." Further, although the same terminology need not be used, "the elements must be arranged as required by the claim."

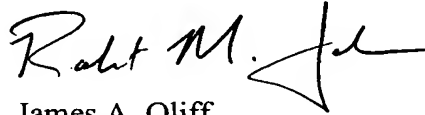
The Office Action improperly ignores these requirements for anticipation by attempting to modify the embodiment of Fig. 16 of Shigemura with the embodiment of Fig. 26, picking and choosing allegedly corresponding features from differing embodiments to attempt to show anticipation by the reference. Clearly, the standard for anticipation is not met with this combination because neither of the embodiments shows the combination of all of the features arranged as in the claim and modifying one embodiment with the other would improperly vitiate positively recited claim terms.

For at least the foregoing reasons, Shigemura cannot reasonably be considered to teach an apparatus or a method having the combination of all of the features positively recited in the independent claims. Further, dependent claims 45-48 are also not taught by Shigemura for at least the respective dependence of these claims on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites. Accordingly, reconsideration and withdrawal of the rejection of claims 41-48 under 35 U.S.C. §102(e) over Shigemura are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 41-48 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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